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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.               | CONFIRMATION NO.       |
|--|-------------|----------------------|-----------------------------------|------------------------|
| 10/750,139   | 06/03/2004  | Jessica R. DesNoyer  | 50623.326                         | 2159                   |
| 7590 10/10/2007<br>Squire, Sanders & Dempsey, L.L.P.<br>Suite 300<br>1 Maritime Plaza<br>San Francisco, CA 94111 |             |                      | EXAMINER<br>ROGERS, JAMES WILLIAM |                        |
|  |             |                      | ART UNIT<br>1618                  | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>10/10/2007           | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

### Application No.

10/750,139

### Applicant(s)

DESNOYER ET AL.

### Examiner

James W. Rogers, Ph.D.

### Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Response to Amendment*

The amendment to the claims filed 09/12/2007 has been entered. Applicants have amended claim 4. Any objection/rejection from the previous office action filed 04/30/2007 not addressed in the office action below has been withdrawn.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roby et al. (WO 98/32398 A1, cited previously) in view of Pinchuck et al. (US 2002/0107330), this new rejection was necessitated by amendment.

Roby was disclosed previously in the office action dated 06/12/2007. Roby discloses PEA polymers useful in coating surgical devices. Roby does not disclose the low surface energy polymers as recited in claim 4.

Pinchuck discloses coatings over an intravascular or intervascular medical device comprising a biocompatible polymer that comprises an A block and a B block, the A-block includes polyolefin monomers that when polymerized will form an alkyl chain and a B-block that includes monomers of methacrylates. See abstract and [0027]-[0036]. Pinchuck also discloses that the medical devices can further comprise a copolymer that includes blocks of the following polymers polycaprolactone, polyglycolic acid, siloxane polymers and the like. See [0016]. Either of the copolymers described above would meet applicants claimed low surface energy polymer as recited in claim 4.

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Thus the claimed invention would have been *prima facie* obvious since all the claimed elements such as PEA and the copolymers of claim 4 were known to be useful in coating medical devices and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

### ***Response to Arguments***

Claims 1-3,5-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pacetti (WO 03/022323 A1, cited by applicants in IDS filed 11/06/2006) and in view of Roby et al. (WO 98/32398 A1, cited by applicant in IDS filed 11/06/2006), for the reasons set forth in the office action dated 06/12/2007.

Applicant's arguments filed 09/12/2007 have been fully considered but they are not persuasive.

Applicants asserts that neither Pacetti or Roby disclose a low surface energy surface blooming polymer or polymer additive that includes a miscible PEA block or backbone nor do they teach or suggest a method of forming a coating for an implantable device using the above polymer combination.

The relevance of this assertion is unclear. Since by combination the two references disclose the same type of polymers and the same type of polymer additives the claim limitation is obviously met because the same compounds will have the same miscibility properties. Roby discloses PEA polymers in coating surgical devices while

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Pacetti discloses polyurethanes with a polydimethylsiloxane soft segments useful in coating stents. From applicants own specification polyurethanes with a polydimethylsiloxane soft segment would meet a low surface energy surface blooming polymer or polymer additive that includes a miscible PEA block or backbone. See page 3 lin 15-page 4 lin 14 of applicants specification. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable.

### ***Conclusion***

No claims are allowed at this time.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 271-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MICHAEL G. HARTLEY  
SUPERVISORY PATENT EXAMINER